

Remarks:

Claims 1-16 and 21 are pending. Claims 1-16 and 21 are rejected under 35 U.S.C. §103. This application is amended by the virtue of this response, pursuant to 37 CFR 1.121. Please amend claims 1 and 9. Please cancel claims 3, 12, and 21. No new matter is added. Support for the amended or the new claims is provided within the specification and the claims as filed.

The Applicant is not conceding that the subject matter recited in the amended or canceled claims is not patentable over the art cited by the Examiner. The amended, withdrawn or cancelled claims are provided solely to facilitate expeditious prosecution of the allowable subject matter. Applicant respectfully reserves the right to pursue claims, including the subject matter encompassed by the amended or cancelled claims in one or more continuing applications.

Claim of Priority:

Applicant notes that the Examiner has not acknowledge the Applicant's claim of foreign priority under 35 U.S.C. § 119(a). None of the boxes were marked on the Office Summary page. Please let us know if all, some or none of the copies have been received.

Figures:

Applicant notes that none of the boxes were marked on the Office Summary page to indicate that the Examiner has accepted the Drawings. Please advise.

§103 Rejection(s):

Claims 1-16 and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pub. No. 2003/0002476 to Chung et al. (hereafter "Chung"), in view of U.S. Patent No. 7,457,278 to Son et al. (hereinafter "Son"). This rejection is respectfully traversed.

It is preliminary noted that it seems that Son is an improper reference in that it does not qualify as a prior art reference in this matter under 35 U.S.C. §102. Please note that neither the filing date, the publication date, or the 371(c)(1) date associated with Son predate neither the filing date of the present application nor the filing date of the application to which priority is

claimed. Accordingly, for this reason alone, it is requested that the pending 103 rejection to be withdrawn.

It has been long held that to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

In other words, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Further, according to MPEP §2143,¹ to establish a prima facie case of obviousness, the Examiner must clearly articulate the reason(s) why the claimed subject matter would have been obvious at the time of invention. Exemplary rationales that may support a conclusion of obviousness include:

- (a) Combining prior art elements according to known methods to yield predictable results;
- (b) Simple substitution of one known element for another to obtain predictable results;
- (c) Use of known technique to improve similar devices (methods, or products) in the same way;
- (d) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; etc.

¹ *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739-1741, 82 USPQ 2d 1385, 1395-97 (2007).

The claimed subject matter is directed to a method of generating a ring back tone, the method comprising receiving by a first terminal a request for a call setup generated by a second terminal, wherein the first terminal communicates over a voice over internet protocol (VOIP) network and the second terminal communicates over public switched telephone network (PSTN), wherein the VOIP and the PSTN networks are connected by way of a trunk gateway; identifying a type of a network to which the second terminal requesting the call setup belongs; generating ring back tone data independently by the first terminal, if the type of the network is a public switched telephone network; storing the generated ring back tone data in a buffer; inserting the ring back tone data into a response after reading out the ring back tone from the buffer; and transmitting the response message from the first terminal to the second terminal in response to the call setup, wherein the ring back tone is inserted into the response message according to a first-in first-out method, wherein the response message is transmitted to the port informed by the trunk gateway during the call setup, wherein the second terminal receives the response message and generates a ring back tone according to the ring back tone data included by the first terminal into the response message.

It is noteworthy that in the claims “[a] functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step.” MPEP § 2173.05. As provided in further detail below, the cited references fail to teach and suggest all the above-noted elements and functional relationship recited in the pending claims.

Chung discloses a gateway call routing system used to route calls, wherein the gateway connects a PSTN and the Internet. The call routing system includes a first computer connection module for connecting to a computer terminal, such as an Internet voice terminal, of a calling party, and a first phone connection module for connecting to a phone terminal of the calling party. In addition, the call routing system includes a second computer connection module for connecting to a computer terminal of a called party, and a second phone connection module for connecting to a phone terminal of the called party. Further, the call routing system includes a

voice tuning module which sets voice tuning to a phone-to-phone mode if the terminal of the calling party is a phone and the terminal of the called party is also a phone, to a computer-to-phone mode if the terminal of the calling party is a computer and the terminal of the called party is a phone, to a phone-to-computer mode if the terminal of the calling party is a phone and the terminal of the called party is a computer, and to a computer-to-computer mode if the terminal of the calling party is a computer and the terminal of the called party is also a computer.

The Applicant has carefully reviewed Chung and it is respectfully submitted that Chung fails to teach or suggest all the above recited elements. Particularly, Chung fails to disclose the ring-back tone. Further, Chung directly teaches away from the first terminal independently generating ring back tone data, as recited in claim 1. Chung suggests that a ring signal (i.e., the ring back tone data) is generated by PSTN 114 and sent to the calling party. See paragraph [0023] and figure 3. In contrast, claim 1 recites that the ring back tone is independently generated by the by the first terminal without any help from a PSTN switchboard or access gateway. See Specification, paragraph [0052]. Therefore, a person of ordinary skill in the art could not be motivated to combine Chung with any other reference as the resulting combination would also teach away from the first terminal independently generating ring back tone data.

Son fails to cure the deficiencies of Chung. Son discloses a VoIP gateway that serves to send a connection request to either the IP network or the PSTN on the basis of the information stored in the VOIP gateway and the destination telephone number contained in the connection request as sent from the telephone terminal. If a connection request is decided to be sent to the IP network, the VOIP gateway sends the connection request to the PSTN when the IP network state judgment unit judges that the communication through the IP network is impossible. Furthermore, if a destination telephone number includes predetermined identification information, the VOIP gateway can forcibly send the connection request to the PSTN. Son fails to suggest generating ring-back tone when the type of the network is a public switched telephone network, as claimed.

It is respectfully noted that §103 does not allow the Examiner to engage in a picking and choosing from the prior art only to the extent that it will support a holding of obviousness, while

excluding parts of the prior art essential to the full appreciation of what the prior art suggests to one of ordinary skill in the art. *In re Wesslau*, 147 USPQ 391 (CCPA 1975).

The question of whether a cited reference can properly be modified in a §103 rejection is not whether a particular limitation was known at time of invention, but rather whether there is a reason that would make it obvious for one of ordinary skill in the art at the time of the invention to modify the cited reference to include that particular limitation. As the U.S. Supreme Court has affirmed, "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art... it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." See *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ 2d 1385, 1397 (2007).

Additionally, it is improper to use Applicant's disclosure as a road map for selecting and combining prior art references. See *Grain Processing Corp. v. American Maize-Products Corp.*, 840 F.2d 902, 907 (Fed. Cir. 1988). Applicant respectfully submits that in the absence of any legitimate reason that it would be obvious to combine the cited references, the Office Action has used Applicants' claims as a road map for modifying the cited reference.

While the suggestion to modify this reference may come from the knowledge and common sense of a person of ordinary skill in the art, the fact that such knowledge may have been within the province of the ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge. *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998).

Here, the modification proposed by the Examiner is not based on any clear and convincing evidence of a reason, suggestion, or motivation in the prior art that would have led one of ordinary skill in the art to combine the references. Rather, the reason, suggestion and motivation for the combination of references proposed by the Examiner simply is impermissible hindsight reconstruction given the benefit of Appellant's disclosure.

The Federal Circuit has consistently held that hindsight reconstruction does not constitute a prima facie case of obviousness under 35 U.S.C. § 103. *In re Geiger*, 2 USPQ2d 1276 (Fed Cir. 1987). Unfortunately, the Examiner rather than pointing to what the prior art discloses and teaches as to making the suggested modification relies on assumptions and statements without any support in the record. As such, the Examiner's statements regarding obviousness and motivation to modify are but shortcuts to a conclusion of obviousness devoid of the required analytical approach based on what is actually disclosed in the prior art.

Reliance on impermissible hindsight to avoid express limitations in the claims and setting forth unsupported hypothetical teachings to recreate the Applicant's claimed invention cannot establish a prima facie case of obviousness. Since obviousness may not be established by hindsight reconstruction, Applicant invites the Examiner to point out the alleged motivation to combine with specificity,² or alternatively provide a reference or affidavit in support thereof, pursuant to MPEP §2144.03.³

Since no reasonable justification is provided in the Office Action as to how such modification or combination is possible and obviousness may not be established based on hindsight and conjecture, it is respectfully requested that the §103 rejection be withdrawn. For the above reasons, none of the cited references, either alone or in combination, teach or suggest all the elements recited in the claims. Therefore, it is respectfully submitted that the claims are in condition for allowance.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references.

² *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

³ "The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner."

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to contact the undersigned attorney at the Los Angeles, California, telephone number (213) 623-2221 or jfar-hadian@lhlaw.com to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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